



*In re Application of
Richley et al.*

Serial No. 09/448,088

Filed: November 23, 1999

10 For: Laser Locating and Tracking System
For Externally Activated Tags

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Commissioner for Patents
Mail Stop Non-Fee Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

In response to the first Office action mailed on May 9, 2003, for the⁸ above-referenced patent application, please consider the following remarks. A Petition for Extension of Time Under 37 CFR § 1.36(a), requesting a one-month extension of time, is included with this Response.

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Claims 1, 3-13 remain in this application. No claims have been amended.

Claims 1 and 3 stand rejected under the judicially created doctrine of double patenting over Claims 1-3 of commonly assigned U.S. Patent No. 6,542,083. A Terminal Disclaimer is enclosed. Withdrawal of the rejection for double patenting is requested.

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Claims 1, 3, 4, and 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,134, to Bowers, in view of U.S. Patent No. 6,278,538, to Schleipen. Applicant traverses the rejection. To establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the

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combined references must teach or suggest all the claim limitations. MPEP § 2143. The Bowers and Schleipen references, taken either singly or in combination, fail to teach or suggest all the claim limitations and therefore do not render claims 1, 3, 4, and 9 obvious.

5 Neither Bowers nor Schleipen teaches or suggests to one of ordinary skill in the art to modify or combine the reference teachings to create a system for identification and tracking of tags distributed in a room, as defined by claims 1, 3, 4, and 9. Bowers teaches an article inventory control system using radio frequency identification (RFID) tags attached to each inventoried article. Each
10 tag has a unique identification or serial number and is reactive to radio frequency (RF) scanning beams. RFID scanners are used to scan the articles with the tags and an inventory database is used to track the tagged articles as the articles enter and leave a general area, such as a room.

 Schleipen teaches an optical scanner having a radiation source for
15 generating a radiation beam and means for providing the radiation beam with a scanning movement. The Schleipen device provides a scanner with a high scanning rate by using one mechanical rotation instead of two rotations and by eliminating the use of a telescope.

 Taken individually, Bowers teaches an inventory system for keeping track
20 of articles by scanning RFID tags attached to the articles. The device provides a convenient and more precise way of maintaining accurate records of currently available and currently outstanding articles. As articles enter or leave a controlled area, an inventory database is automatically updated by scanning the RFID tags attached to each article.

25 Bowers, however, actually teaches away from claims 1, 3, 4, and 9. The focus of the Bowers device is to locate articles in a general area by scanning the area with RF beams. Bowers discloses tracking the tagged articles as the articles enter and leave a general area, such as a room. When the tagged articles enter into the general zone, interrogators scan and detect disturbances received in
30 response to signals caused by the presence of a tag within the general area. The

precise location of the articles is not important. The inventoried articles need only be located somewhere within the general area. In a sense, Bowers teaches a system that detects only the presence or absence of a tagged article within a general area and fails to teach or suggest determining the position of the tagged article within the general area. Accordingly, Bowers fails to teach or suggest storing state records of position and informational content, as recited in claims 1, 3, 4, and 9.

Bowers also fails to teach or suggest tags or scanners utilizing laser or any form of energy waveform other than radio frequency. Instead, Bowers relies on RF signals, which are unidirectional and imprecise and of little moment in precisely locating articles within a general area. Accordingly, Bowers further fails to teach or suggest storing state records of position and informational content, as recited in claims 1, 3, 4, and 9.

Taken individually, Schleipen teaches a fast-scanning optical scanner that utilizes only one mechanical movement to scan a two-dimensional space by modulating emitted wavelength of the scanning laser beam. Schleipen discloses using scanning beams to locate an object in space and requires line of sight.

In combination, Bowers and Schleipen would result in an inoperative result. The Bowers reference discloses utilizing RF waves as scanning beams, which enables the detection of RFID tags within a general area, such as a room. By using RF, Bowers does not require a direct line of sight to locate articles within the general area because RF waves are unidirectional and imprecisely propagate throughout an enclosed space, thereby preventing the determination of a precise location for a tracked article, as per claims 1, 3, 4, and 9. Furthermore, the Schleipen reference discloses utilizing optical scanners, which require a direct line of sight.

Thus, one skilled in the art would not be motivated to combine the teachings of Bowers with the teachings of Schleipen to provide a system for identification and tracking of tags distributed in a room. Bowers teaches a unidirectional system that can only determine whether a RFID tagged article is

present or absent from a general area, whereas Schleipen teaches an optical scanner that requires a line of sight to locate an object. Therefore, combining the teachings of the Schleipen reference with the teachings of the Bowers reference would result in a system for scanning using optical waves in a general area for tags that can be out of a direct line of sight with the optical scanner and not a system for identification and tracking of tags distributed in a room, per claims 1, 3, 4, and 9.

As a result, there would be no reasonable expectation of success to combine the Bowers and Schleipen references. First, combining the references would result in an inoperative result. Also, neither reference teaches or suggests the use of tags reactive to laser scanning beams. Bowers uses RF and Schleipen uses optical. Finally, neither references teaches or suggests that both the state information from the tags and the precise location can be determined at once.

Consequently, a *prima facie* case of obviousness has not been shown. Claims 4 depends on Claim 1 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Claims 9 depends on Claim 3 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein.

Accordingly, the Bowers and Schleipen references, taken as a whole, fail to teach or suggest the claimed subject matter of claims 1, 3, 4, and 9. As Bowers and Schleipen fail to render claims 1, 3, 4, and 9 obvious, withdrawal of the rejection for obviousness is requested.

Claims 5-8 and 10-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,134, to Bowers, in view of U.S. Patent No. 6,278,538, to Schleipen, and further in view of U.S. Patent No. 6,005,482, to Moran. Applicant traverses the rejection.

Claims 5-8 depend on claim 1 and are patentable for the above-stated reasons with respect to the rejection of claim 1 under 35 U.S.C. 103(a), and as further distinguished by the limitations recited therein. Claims 10-13 depend on claim 3 patentable for the above-stated reasons with respect to the rejection of

claim 1 under 35 U.S.C. 103(a), and as further distinguished by the limitations recited therein.

Accordingly, the Bowers, Schleipen, and Moran references, taken as a whole, fail to teach or suggest the claimed subject matter of claims 5-8 and 10-13.

- 5 As Bowers, Schleipen, and Moran fail to render claims 5-8 and 10-13 obvious, withdrawal of the rejection for obviousness is requested.

The prior art made of record and not relied upon has been reviewed by the applicant and is considered to be no more pertinent than the prior art references already applied.

- 10 Entry of the foregoing remarks is requested and a Notice of Allowance is earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

Respectfully submitted,

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Dated: September 9, 2003

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